

**REMARKS/ARGUMENTS**

**Drawings:**

The Examiner has objected to the “drawing(s) filed on May 28, 2002.” (Paper No 8, Office Action Summary, ¶ 10) Although the Examiner does not provide any explanation for this objection, it appears that the reason for the objection is an inadvertent error made by Applicants in submitting an amended Figure 2A received by the Patent Office on that date.

The previous amendment was submitted to correct a typographical error in original Figure 2A showing a “*RETRIEVAL* SCANNER CONTROL” (268) and “*RETRIEVAL* SCANNER” (267). As reflected in the original specification, these two items should have been labeled “*RETINAL* SCANNER CONTROL” and “*RETINAL* SCANNER”. (See, e.g., Paragraph no. 57 of the published application for the present application: “Transaction terminal 10 can also include a *retinal* scan unit including scanner 267 associated control circuit 268.”) Although the formal drawing for Fig. 2A received by the Patent Office on May 28, 2002 corrected the errors, the originally submitted red ink marking drawing still showed the items as “RETRIEVAL . . . .”

The attached drawing sheet includes changes to Fig. 2A. This sheet replaces the original sheet including Fig. 2A. In Fig. 2A, the text of “*RETRIEVAL* SCANNER CONTROL” (268) and “*RETRIEVAL* SCANNER” (267) has been changed to “*RETINAL* SCANNER CONTROL” (268) and “*RETINAL* SCANNER” (267) respectively. Accordingly, Applicants respectfully request that the Examiner withdraw the objection to the drawing.

**Claims:**

In order to simplify the issues for consideration by the Examiner and to expedite allowance of the present application, Applicants have canceled claims 1-24, 30, and 37 without prejudice or disclaimer. Applicants specifically reserve the right to pursue patenting of the subject matter of the canceled claims in the present application or in a related application (e.g., a continuation). Applicants seek entry of new claims 39-77 that are believed to be supported by the original specification and do not contain new matter. Claims 25-29, 31-36, and 38-77 are presently in this application.

The Applicants' cancellation without prejudice of certain claims will not be taken as an indication that the Applicants agree that the standing claim rejections are proper. In fact, Applicants note that, regarding several previously submitted claims, the Examiner has not fully considered several specifically recited claim limitations. For example, as will be discussed herein, the Examiner resorts in several instances to a weak "design choice" type rejection where the Examiner can point to no prior art in support of the Examiner's rejections. Regarding original claim 8 reciting a detachable stylus holder in a specific combination with other specifically recited elements, the Examiner relies upon a prior art teachings showing a stylus, but a not a stylus holder, much less a stylus holder in the particular combination recited by the Applicants. Regarding original claim 21 reciting an encryption mode feature in combination with other elements wherein as part of the encryption mode feature an encryption mode indicator is incorporated, the Examiner does not attempt to show the encryption mode indicator anywhere in the prior art. Regarding original claim 24 reciting an imaging assembly incorporated in a housing of the terminal in combination with other specifically recited elements, the Examiner (Paper No. 8, p. 9, ¶ 1) asserts that the following teaching of Valliani constitutes a teaching of the combination of elements recited in original claim 24:

Referring to FIG. 1, device 10 will include a central processor unit ("CPU") 20, memory including ROM and RAM, collectively 30, and optionally other storage 40, e.g., a hard disk in a laptop device, or flash memory in a PDA. Software 35 and/or 45 used to augment the present invention may be loaded or stored in such memory, for execution by CPU 20. Device 10 will include an input 50, which can include real or virtual (displayable touch) keys, a stylus, and an infrared port. Device 10 will also include an output such as display 60 (typically a liquid crystal display, or "LCD").

Device 10 typically includes modem capability, in addition to other modes of communication. For example, modern devices 10 frequently are provided with a wireless unit 65 that can include infrared ("IR") and/or radio frequency transmission/reception capability for wireless communications. Device 10 will commonly include serial and/or parallel interface ports 70. Using unit 65 and/or ports 70, device 10 can communicate with a remote host system 75, using an internal modem. (*Valliani, column 4, lines 4-21*)

The Examiner is respectfully requested to explain where Valliani, column 4, lines 4-21, teaches an imaging assembly incorporated in a housing in such manner that light received by the imaging assembly passes through an imaging assembly aperture.

Applicants in the present response present claims having recited elements related to the claim elements referenced above in new combinations. The Examiner is respectfully requested to fully consider all of the claim limitations of Applicants' claims in the context of the combinations claimed.

## **1. Rejections Under 35 U.S.C. §112, First Paragraph**

### **Applicable Standard**

In order to satisfy the written description requirement under 35 U.S.C. §112, first paragraph, "a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the invention." MPEP § 2163; *Vas Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). "The analysis of whether the specification complies with the written description calls for the examiner to compare the scope of the claim with the scope of the description to determine whether the applicant has demonstrated possession of the claimed invention." MPEP § 2163. Since this analysis and review is conducted from the standpoint of one of ordinary skill in the art at the time the application was filed, *see, e.g., Vas Cath, Inc.*, 935 F.2d at 1563, there is generally "an inverse correlation between the level of skill and knowledge in the art and the specificity of the disclosure necessary to satisfy the written description requirement." MPEP §2163

"Compliance with the written description requirement is a question of fact that must be resolved on a case-by-case basis." MPEP §2163; *In re Smith*, 458 F.2d 1389, 1395 (C.C.P.A. 1972). An applicant shows possession of the claimed invention "by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997); MPEP §2163. The Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, have routinely held that the written description requirement can be satisfied with drawings alone. *See, e.g., In re Wolfen-sperger*, 302 F.2d 950, 955 (C.C.P.A. 1962)("The board's statement that 'drawings alone cannot form the basis of a valid claim' is too broad a generalization to be valid and is, furthermore, contrary to well-settled and long-established Patent Office practice."); *Vas Cath, Inc.*, 935 F.2d at 1564 ("We agree with the district court's conclusion that drawings alone *may* be sufficient to provide the 'written

description of the invention' required by §112, first paragraph.") (emphasis in original); *Wang Labs. v. Toshiba Corp.*, 993 F.2d 858, 866 (Fed. Cir. 1993); *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1322 (Fed. Cir. 2002); *Koito Mfg. Co. v. Turn-key Tech, LLC*, 381 F.3d 1142, 1154-55 (Fed. Cir. 2004). Further evidence that drawings alone are sufficient to satisfy the written description requirement of §112, first paragraph, is the fact that, under certain circumstances, utility applications may rely on the benefit of the filing date of an earlier design application. *See* MPEP §1504.20.

### **Claims 25-28**

The Examiner has rejected claims 25-28 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. (Paper No. 8, p. 2, ¶ 1) The Examiner asserts that the limitation "wherein said housing includes a portion configured by grasping by a customer while the customer enters data using the touch screen" of claim 25 has "nowhere been disclosed in the specification." (*Id.*) Applicants respectfully submit that the specification does in fact disclose this limitation in sufficient detail to comply with the written description requirement of 35 U.S.C. §112. For example, originally filed Figures 1A, 1B, 1C, 1D, 1E, 1G, 1H, 1I, 1J, 1K, 1L, 1M, 1P, 1Q, and 1S, disclose several views and illustrations of the housing 11 of the transaction terminal 10, including the enlarged head portion 11h and lips 11l defined therein. This structure is also described at paragraph nos. 48 and 49 in the Detailed Description of the Invention of the published application for the present application. These figures and accompanying textual description, disclosing a transaction terminal with sufficient surface area for a customer to grasp while using the touch screen, demonstrate that Applicants possessed the idea of a housing with a "portion configured by grasping by a customer while the customer enters data using the touch screen" at the time of filing. As discussed above, when as in the present case, drawings are sufficient or perhaps even more effective to describe the claimed invention, drawings alone satisfy the written description requirement of §112. *See, e.g., Vas Cath, Inc.*, 935 F.2d at 1564. Accordingly, Applicants respectfully submit that, for at least these reasons, the specifications' figures and accompanying text satisfy the written description requirement for independent claim 25 and dependent claims 26 through 28, each claiming additional features of the "portion configured for grasping" that are also disclosed in the cited figures.

**Claims 32-35**

The Examiner has rejected claims 32-35 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. (Paper No. 8, p. 2, ¶ 1) The Examiner asserts that the limitation “sideward extending lip extends at least about (0.25 inch, 0.50 inch .0.75 inch),” of claims 32-34 have “nowhere been disclosed in the specification.” (Paper No. 8, p. 2, ¶ 1) Applicants respectfully submit that the specification does in fact disclose these limitations in sufficient detail to comply with the written description requirement of 35 U.S.C. §112. For example, the originally filed Detailed Description of the Invention indicates that “[d]imensional information relating to terminal 10 in one exemplary preferred embodiment is summarized in FIGS. 1r, 1s, 1t and 1u wherein dimensional information is given in inches.” (Paragraph no. 140 of the published application for the present application) Figure 1S shows the overall dimensions of a preferred embodiment of the transaction terminal 10 to be 9.745” by 8.254”. Given these dimensions as well as the views of the lip 111 provided by Figure 1S as well as the other figures, a person of ordinary skill in the art could easily determine that the lip 111 extends by at least the dimensions provided in claims 32-34. Accordingly, Applicants respectfully submit that, for at least these reasons, the specifications’ figures and accompanying text satisfy the written description requirement for dependent claims 32 through 34.

The Examiner has also rejected claim 35 as failing to comply with the written description requirement, but offers no explanation. (Paper No. 8, p. 2, ¶ 1) Claim 35 depends upon claim 29 and adds the limitation of a “second sideward extending lip disposed opposite said first sideward extending lip” of independent claim 29. Applicants respectfully submit that the specification does in fact disclose this limitation in sufficient detail to comply with the written description requirement of 35 U.S.C. §112. For example, originally filed Figure 1E expressly discloses the existence of two lips 111 and therefore expressly discloses the “second sideward extending lip disposed opposite said first sideward extending lip” of claim 35. Accordingly, Applicants respectfully submit that, for at least these reasons, the specifications’ figures and accompanying text satisfy the written description requirement for dependent claim 35.

**Claim 38**

The Examiner has also rejected claim 38 as failing to comply with the written description requirement, but offers no explanation. (Paper No. 8, p. 2, ¶ 1) Claim 38 depends upon claim 36 and adds the limitation that the “circumferentially extending lip” of claim 36 is “configured for grasping by either hand of the user.” Applicants respectfully submit that based on the reasons set forth above, the specifications’ figures and accompanying text also satisfy the written description requirement for claim 38.

**2. Rejections Under 35 U.S.C. §103**

**Applicable Standard**

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP § 2142. MPEP §§ 2142 and 2143 set forth the three basic criteria that must be met in order for an Examiner to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to support a conclusion that a “claimed invention is directed to claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), cited in MPEP § 2144. In attempting to establish this required “convincing line of reasoning” to support a § 103 rejection, an Examiner cannot resort to “hindsight” based on the Applicant’s disclosure, but instead must reach any determination of obviousness “on the basis of facts gleaned from the prior art.” MPEP § 2142. Furthermore, [i]t is never appropriate [for an Examiner] to rely solely on ‘common knowledge’ in the art

without evidentiary support in the record, as the principal evidence upon which a rejection is based.” MPEP §2144.03; *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001)

The Federal Circuit routinely reverses § 103 obviousness rejections that are not supported by the required “convincing line of reasoning” by an examiner. For example, the Federal Circuit has established that a § 103 obviousness rejection cannot be premised on the conclusory assertion that a prior art device *may* be modified to produce the claimed invention unless the prior art also suggests the desirability of the combination. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992); *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); MPEP §2143.01. Similarly, § 103 obviousness rejections asserting that the claimed invention is merely a relatively simple or minor design change to the prior art are also inappropriate. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371-72 (Fed. Cir. 2000); *Innovative Design Enter., Inc. v. Circulair, Inc.*, 1997 WL 534891, at \*8 (N.D. Ill. August 21, 1997); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935 (Fed. Cir. 1990); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Likewise, any § 103 obviousness rejection based on an examiner’s determination that a modification to the prior art would have been “obvious to try” will not stand. *See, e.g., In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987).

Yet another example of an improper § 103 obviousness rejection that does not provide a “convincing line of reasoning” is an assertion by an examiner that the claimed invention is an obvious “design choice” over the prior art. *See In re Chu*, 66 F.3d 292, 298-99 (Fed. Cir. 1995); *In re Gal*, 980 F.2d 717, 719 (Fed. Cir. 1992). The Federal Circuit has held that any rejection based on the mere assertion of “design choice” must fail unless an examiner can point to some teaching or suggestion in the prior art to make that design choice. *In re Chu*, 66 F.3d at 299. Furthermore, any assertion of an obvious “design choice” is “precluded where the claimed structure and the function it performs are different from the prior art.” *Id.* (quoting *In re Gal*, 980 F.2d at 719).

**Claims 25-28**

The Examiner has rejected claims 25-28 under 35 U.S.C. § 103(a) as being unpatentable over Valliani (U.S. Patent No. 6,234,389). (Paper No. 8, p. 3, ¶ 3) Applicants agree with the Examiner that “Valliani does not explicitly disclose a housing including a portion configured for grasping by a customer while the customer enters data using the touch screen” (*Id.* at p. 4). The Examiner nevertheless asserts that claims 25-28 are rendered obvious by Valliani, and without reference to any teaching of the prior art whatsoever, asserts that such a feature is merely a “design choice.” (*Id.*) The entirety of the Examiner’s “design choice” rejection of claims 25-28 is presented below:

However, a portable transaction device including “a housing portion for grasping by a customer while the customer enters data using a touch screen” is a design choice. Such a design would not affect the functionality of Valliani’s point of sale transaction system.

As to claims 26-28, the claims have substantially the limitations of claim 25; therefore, they are analyzed as previously discussed in claim 25 above. (*Id.*)

The Examiner’s conclusory statement that the presently claimed feature of “a housing portion for grasping by a customer while the customer enters data using a touch screen” would be an obvious design choice does not even come close to establishing any of the three basic criteria that must be met in order for an examiner to establish a *prima facie* case of obviousness. MPEP §§ 2142, 2143. This bald “design choice” assertion does not extinguish the requirement that an examiner must present a “convincing line of reasoning” why a skilled artisan would have found the claimed feature obvious. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), cited in MPEP § 2144. Furthermore, as discussed above, the Federal Circuit has held that any rejection based on the mere assertion of “design choice” must fail unless an examiner can point to some teaching or suggestion in the prior art to make that design choice. *In re Chu*, 66 F.3d at 299. Here, the Examiner fails to identify any suggestion or motivation, either in Valliani itself or in the knowledge generally available to one of ordinary skill in the art, to modify Valliani to include the claimed grasping feature. See MPEP § 2143.



It is noted that, if the mere assertion of “design choice” were allowed to stand as a bona fide method of establishing the motivation to modify a prior art reference, the same “design choice” rejection could be used to reject virtually any hypothetical claim by any inventor, regardless of the claim elements. If sanctioned, the Examiner’s “design choice” rejection would eliminate any need to consult the teachings of the prior art altogether. Therefore, the assertion of “design choice” cannot be considered to establish of the required “convincing line of reasoning” as to obviousness. *See* MPEP § 2144.

Moreover, any assertion of an obvious “design choice” is “precluded where the claimed structure and the function it performs are different from the prior art” as is the case here. *In re Chu*, 66 F.3d at 299 (*quoting In re Gal*, 980 at 719). Since the Examiner admits that the prior art does not explicitly disclose a housing including a portion configured **for grasping** by a customer while the customer enters data using the touch screen (Paper No. 8, p. 3, ¶ 3), any reliance on “design choice” rationale in support of establishing obviousness of the functional combinations recited in these claims is *per se* improper.<sup>1</sup>

Accordingly, Applicants respectfully submit that for at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 25-28 and request that the Examiner’s rejection be withdrawn.

### Claims 36 and 38

The Examiner has rejected claims 36 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Valliani (U.S. Patent No. 6,234,389). (Paper No. 8, p. 3, ¶ 3) Applicants agree with the Examiner that “Valliani does not explicitly disclose a base, having a

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<sup>1</sup> Applicants wish to point out that while the claimed portion of the housing configured for grasping by a customer has a functional purpose, this does not preclude obtaining design patent protection on the design of the transaction terminal (as presently claimed in co-pending Design Application No. 29/213,962, entitled “Transaction Terminal”). It is clear that “[b]oth design and utility patents may be obtained on an article if the invention resides both in its utility and ornamental appearance.” MPEP §1502.01. The Federal Circuit has articulated a useful test to determine whether a design is “primarily ornamental” and eligible for design patent protection: “if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional.” *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002); *see also L.A. Gear*, 988 F.2d at 1123. Since the design for the grasping portion of the housing of the transaction terminal as shown in the figures of the present application and co-pending design application is one of several that could produce the same or similar grasping function, this can also be eligible for design patent protection.

circumferentially extending lip disposed proximate to a top surface of the base, said circumferentially extending lip extending about substantially the entire perimeter of the top surface.” (*Id.* at p. 5). The Examiner nevertheless asserts that claim 36 is rendered obvious by Valliani, and without reference to any teaching of the prior art whatsoever, asserts that such a feature is merely a “design choice.” (*Id.*) The entirety of the Examiner’s “design choice” rejection of claim 36 is presented below:

However, using a circumferentially extending lip extending about substantially the entire perimeter of said top surface is only a design choice.

The Examiner’s conclusory statement that the presently claimed feature of “a circumferentially extending lip having an arcuate surface and extending about substantially the entire perimeter of said housing” would be an obvious design choice does not even come close to establishing any of the three basic criteria that must be met in order for an examiner to establish a *prima facie* case of obviousness. MPEP §§ 2142, 2143. This bald “design choice” assertion does not extinguish the requirement that an examiner must present a “convincing line of reasoning” why a skilled artisan would have found the claimed feature obvious. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), cited in MPEP § 2144. Furthermore, as discussed above, the Federal Circuit has held that any rejection based on the mere assertion of “design choice” must fail unless an examiner can point to some teaching or suggestion in the prior art to make that design choice. *In re Chu*, 66 F.3d at 299. Here, the Examiner fails to identify any suggestion or motivation, either in Valliani itself or in the knowledge generally available to one of ordinary skill in the art, to modify Valliani to include the claimed circumferentially extending lip. *See* MPEP § 2143.

Accordingly, Applicants respectfully submit that for at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 36 and request that the Examiner’s rejection be withdrawn.

Since the Examiner has rejected claim 38 based solely on the analysis with respect to claim 25 (Paper No. 8, p. 4), for the reasons set forth above, Applicants respectfully submit that the Examiner’s rejection with respect to claim 38 was improper. Furthermore, since claim 38 depends from claim 36 and “[d]ependent claims are nonobvious under section 103 if

the independent claims from which they depend are nonobvious,” *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988), Applicants also request that the Examiner’s rejection be withdrawn.

#### **Claims 29-31**

The Examiner has rejected claims 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Valliani (U.S. Patent No. 6,234,389). (Paper No. 8, p. 3, ¶ 3) Applicants have amended claim 29 to clarify terminology (replacing base with housing) and to incorporate the limitation(s) of claim 30 (*i.e.*, “first sideward extending lip having an arcuate surface”), which has been canceled. Examiner asserts that “Valliani (figs. 2-3, 5-6) shows a transaction terminal (200), wherein the sideward extending lip is an arcuate surface including a compound curvature.” (*Id.* at p. 5) Applicants respectfully submit that Valliani does not disclose a sideward extending lip having an arcuate surface as required by the currently amended claim 29 (incorporating the limitation of canceled claim 30). None of the figures in Valliani cited by the Examiner disclose this feature. Accordingly, Applicants respectfully submit that for at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 29.

Applicants also respectfully submit that Valliani does not disclose a sideward extending lip having an arcuate surface including a compound curvature as required by the claim 31. Furthermore, since claim 31 depends from claim 29 and “[d]ependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious,” *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988), Applicants also request that the Examiner’s rejection be withdrawn.

#### **New Claims**

Claims 39-77 have been added to the application. Although Applicants believe and have demonstrated above that the existing claims are patentable and should be allowed, Applicants have included these new more narrow claims in order to expedite allowance of the claimed subject matter.

Newly added independent claim 44 and all claims depending thereon include the limitation of a “circumferential lip extending outwardly from said base, said circumferential

lip having an arcuate surface and extending about substantially the entire perimeter of said housing.” As discussed above with respect to claim 36, since the Examiner agrees that the prior art does not disclose this limitation, nor provide any suggestion or motivation to include this feature, Applicants respectfully submit that these new claims are also patentable over the prior art.

Newly added independent claim 64 and all claims depending thereon include the limitation of an “enlarged head portion, said enlarged head portion having a top surface, . . . wherein said enlarged head portion defines a curved profile both from a top view of said transaction terminal and at least one of a side view and a front view of said transaction terminal.” This “enlarged head portion” was claimed previously in canceled claim 1, which the Examiner rejected despite admitting that the prior art “does not explicitly disclose an enlarged head portion extending forwardly from the base to define a lip.” (Paper No. 8, p. 3, ¶ 3) The Examiner nevertheless asserts that canceled claim 1 was rendered obvious by Valliani, and without reference to any teaching of the prior art whatsoever, asserts that such a feature is merely a “design choice.” (*Id.*) The entirety of the Examiner’s “design choice” rejection of claim 1 is presented below:

However, a portable transaction device including “an enlarged head portion extending forwardly from the base to define a lip” is a design choice. This would not affect the good functionality of Valliani’s point of sale transaction system. (*Id.*)

As discussed above, the Examiner’s conclusory statement that the presently claimed “enlarged head portion” feature would be an obvious design choice does not even come close to establishing any of the three basic criteria that must be met in order for an examiner to establish a *prima facie* case of obviousness. MPEP §§ 2142, 2143. Accordingly, Applicants respectfully submit that these new claims are also patentable over the prior art.

Regarding new claim 70, new claim 70 is believed to be allowable for the reason claim 70 recites combination of elements not shown or suggested in the prior art. Among other combinations of elements, claim 70 recites the combination in a transaction terminal of an enlarged head portion extending from a base to define a lip and a detachable stylus holder, which combination provides excellent flexibility and ease of use in signature information

entry system. Regarding the enlarged head portion feature, it has been discussed previously that the Examiner, without referencing any technical teaching of any prior art reference whatsoever, resorted to the “design choice” type rejection in rejecting original claim 1, that recited a narrow version of the enlarged head portion feature in combination with other elements. For reasons set forth herein it is believed that the Examiner’s “design choice” rejections are improper and should be withdrawn. Applicants previously recited a combination including the detachable stylus holder feature in original claim 10. In rejecting original claim 10, the Examiner held that Valliani teaches a detachable stylus holder. Specifically, the Examiner asserted that “As to claim 10, Valliani (Fig. 6) shows a transaction terminal, further comprising a detachable stylus (360). It is inherent that a stylus holder is detachably attachable on said housing.” (Paper 8, p. 6) The applicant’s note that the Examiner in attempting to establish that applicants’ combination including a detachable stylus holder feature in combination with other specifically recited elements is obvious, made reference only to a stylus 360 of Valliani, without showing or even attempting to show a stylus holder of any form, much less a detachable stylus in the specific combination recited by the applicants.

Regarding claims 71 – 77, Applicants believe that claims 71-77 are allowable at least for the reason that they depend from an allowable base claim and for the additional combination of elements they recite.

### **3. Conclusion**

In view of the above remarks and amendments, Applicants believe that all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants’ attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants’ representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

**U. S. Patent Application No. 10/044,119**  
**Amendment Dated July 7, 2005**  
**Reply to Office Action Dated March 7, 2005**

Respectfully submitted,  
WALL MARJAMA & BILINSKI

Date: July 7, 2005

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**AMENDMENTS TO THE DRAWINGS**

The attached drawing sheet includes changes to Fig. 2A. This sheet replaces the original sheet including Fig. 2A. In Fig. 2A, the text of “*RETRIEVAL* SCANNER CONTROL” (268) and “*RETRIEVAL* SCANNER” (267) has been changed to “*RETINAL* SCANNER CONTROL” (268) and “*RETINAL* SCANNER” (267) respectively.

Attachments: Replacement Sheet for Fig. 2A

Annotated Sheet Showing Changes for Fig. 2A

A circular black and white stamp. The outer ring contains the text "OIP E JCS6" at the top and "PATENT &amp; TRADEMARK OFFICE" at the bottom. In the center, the date "JUL 07 2005" is stamped.

